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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,953	04/24/2006	Lilian Labelle	01807.111093.	5981
5514 7590 04/13/2009 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER CALLAHAN, PAUL E				
ART UNIT 2437		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/576,953

**Applicant(s)**

LABELLE ET AL.

**Examiner**

PAUL CALLAHAN

**Art Unit**

2437

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,2 and 6-15 is/are rejected.  
7) ☒ Claim(s) 3-5 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 24 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-850)  
Paper No(s)/Mail Date 5-20-08  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-15 are pending and have been examined.

#### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Specification***

3. The disclosure is objected to because of the following informalities:

The "Brief Description of the Drawings" section of the Specification does not group together all of the drawings descriptions that are related to one another. For example, the description for drawing number 1B does not immediately follow the description for 1A. When published, the Patent will display the related drawings sequentially, i.e., drawing 1B will immediately follow drawing 1A. The readability of the Patent will be enhanced if the Specification is amended to group together the descriptions for related drawings. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 13-15 are rejected under 35 U.S.C. 112, first paragraph because the claims are improper "single means" claim.

The preamble of each claim indicates that they are directed towards a device that comprises a means for carrying out the method of claims 2, 8, and 9 respectively. As such, when one considers that the base claims are method claims, claims 13-15 are such that their scope includes all devices capable of carrying out the methods of claims 2, 8, and 9, and not simply any such devices disclosed in the Applicant's Specification. The Applicant's Specification is therefore not enabling for this claim language. See MPEP Sec. 2164.08(a): "Single Means Claim:" *A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197(Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.*

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 10-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 10-12 are directed towards a computer program stored in an information carrier. However, the claims do not indicate the nature of the computer-readable medium. A review of the pertinent section of the Applicant's Specification at paragraph [0142] indicates that the carrier is not limited only to tangible computer-readable storage media. A reasonably broad construction of the claim language therefore includes carrier media that are electromagnetic data signals. Therefore, the claims set forth only functional descriptive language and are non-statutory since this does not fall into one of the classes of invention eligible for the grant of a US patent. Unless embodied in a tangible computer-readable medium the software in and of itself cannot be considered as a computer component, and hence cannot effect a change of state of a processor to produce a useful or tangible result. From MPEP Sec. 2106.01: Computer-Related Nonstatutory Subject Matter: *Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of*

*"data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data. Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases.*

As for claims 13-15, as per the Applicant's Specification at, for example, paragraphs [0066] and [0104], the means recited by the claims may constitute only computer code, i.e., the method may be carried out entirely in software. However, the claims do not positively recite that such software is embodied in a tangible computer-readable storage medium. Therefore, the claims set forth only functional descriptive language and are non-statutory since this does not fall into one of the classes of invention eligible for the grant of a US patent. Unless embodied in a tangible computer-readable medium the software in and of itself cannot be considered as a computer component, and hence cannot effect a change of state of a processor to produce a useful or tangible result. From MPEP Sec. 2106.01: Computer-Related Nonstatutory Subject Matter: *Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional*

*descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data. Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases.*

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 1, 2 and 6-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Viger et al., US 2005/0228753 A1.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Viger teaches:

As for claim 1, a digital document system in which a digital document in a communication network is shared between a plurality of stations (abstract, [0001]), said system comprising: a first station ([0059], [0093]) having a first digital document ([0087], [0088]) comprising a thumbnail data item ([0088]) and an original data item ([0088]); a second station ([0062], [0063], [0092]) having a second digital document ([0063],[0063]) comprising a thumbnail data item ([0134]); and a center station ([0133]) comprising: calculating means for calculating signatures of the thumbnail data items ([0137], [0145])



of the first and second digital documents ([0062], [0063]); comparing means for comparing the calculated signatures of the thumbnail data items ([0148], [0164], [0169]); and transmitting means for transmitting information for accessing the original data item ([0172]), of the first digital document ([0172]) to the second station ([0172], [0190]) according to a result of the comparison ([0172], [0190]).

As for claim 2, a method of controlling a center station (abstract, [0092]) capable of communicating with a plurality of stations sharing a digital document in a communication network ([0092]), characterized in that it comprises the following steps: a) receiving a thumbnail data item ([0062], [0063], [0137]) comprised in a first station ([0137]) and a thumbnail data item ([0148]) comprised in a second station ([0062], [0063]); b) calculating a signature from each of the received thumbnail data items ([0137]); c) comparing the calculated signatures of the received thumbnail data items ([0164]), and d) transmitting information for accessing an original data item ([0172]) related to the thumbnail data item [0172], [0190]) to the second station ([0172], [0190]) according to a result of the comparison.

As for claim 6, a method according to claim 2, wherein said communication network is a peer-to-peer network ([0092], [0117]).

As for claim 7, a method according to claim 2, wherein the first station is a digital camera apparatus and generates the original data item ([0094]).

As for claim 8, a method of controlling a station (abstract, [0092]) capable of sharing a digital document in a communication network ([0092]), characterized in that it comprises the following steps: i) generating an original data item ([0017], [0018]); ii) generating a thumbnail data item ([0137]) from the original data item ([0137]); iii) transmitting the thumbnail data item ([0137]) to the other station; and iv) receiving an access from said other station to the original data item ([0164], [0172]) based on the thumbnail data item ([0172], [0190]).

As for claim 9, a method of controlling a station capable of sharing a digital document in a communication network (abstract, [0092]), characterized in that it comprises the following steps: 1) receiving a thumbnail data item ([0062], [0063], [0137]) from other station; 2) transmitting the received thumbnail data item ([0137]) to a center station ([0137]); 3) receiving, from the center station ([0062], [0063], [0137]), information for accessing the original data item ([0172], [0190]) related to the thumbnail data item determined based on the thumbnail data item ([0164]).

As for claim 10, a computer program stored in an information carrier, said program comprising instructions enabling the implementation of a processing method according to claim 2, when that program is located and executed by a computer system ([0113]).

As for claim 11, a computer program stored in an information carrier, said program comprising instructions enabling the implementation of a processing method according to claim 8, when that program is located and executed by a computer system ([0113]).

As for claim 12, a computer program stored in an information carrier, said program comprising instructions enabling the implementation of a processing method according to claim 9, when that program is located and executed by a computer system ([0113]).

As for claim 13, a device for accessing a digital document in a communication network characterized in that it comprises means adapted to implement a sharing method according to claim 2 ([0092], [0093]).

As for claim 14, a device for accessing a digital document in a communication network characterized in that it comprises means adapted to implement a sharing method according to claim 8 ([0092], [0093]).

As for claim 15, a device for accessing a digital document in a communication network characterized in that it comprises means adapted to implement a sharing method according to claim 9 ([0092], [0093]).

***Allowable Subject Matter***

10. Claim 3-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US Patent documents disclose methods pertinent to the Applicant's Disclosure for document and image access involving signatures formed on thumbnail data:

Tokie et al.	US 2007/0050626 A1
Alasia et al.	US 2005/0228753 A1
Alasia et al.	US 7,114,074
Ohmori et al.	US 2007/0061582 A1

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone

number for the organization where this application or proceeding is assigned is: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Callahan/  
Art Unit 2437

/Emmanuel L. Moise/  
Supervisory Patent Examiner, Art Unit 2437